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EXAMINER

DUDNIKOV, VADIM

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3663

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/780,802	Applicant(s) KIELBOWICZ, STANISLAW	
	Examiner VADIM DUDNIKOV	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Amendment filed 9/8/2008 forms the basis for this Office Action.

Claim 1 has been amended. Claims 1 and 3-12 have been pending.

Amendment of claim 1 is sufficient to overcome the rejections of claims 1 and 3-12 under 35 U.S.C. 102 (b) and said rejections are withdrawn. A new basis for rejection is established in view of further consideration of Application and consideration and search of the prior art.

Comments on Remarks submitted with said amendments are included below under Response to Arguments.

Response to Arguments

2. Applicant's arguments see pages 5-6, filed 9/8/2008, with respect to of previous Office action have been fully considered but they are not in every respect persuasive. Those rejections and objections that have been overcome by amendment are omitted from the present Office action and are considered withdrawn.

Applicant's remark relating to Obviousness-type Double Patenting over the '190 patent is accepted upon filing of the Terminal Disclaimer.

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Applicant's Arguments relating claim Rejecting under 35 U.S.C. 102 (b) is persuasive and rejection of amended claims are established in light of further consideration and/or search of the prior Art. See rejections underneath.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claim 1 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 7,211,190 B2 ('190 hereinafter).

Although the conflicting claims are not identical, they are not patentably distinct from each other because limitations of Applicant's claim 1 are obvious over the claim

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limitations of said US Patent as shown below (at least of broadest reasonable claims interpretation).

Claim 1 of Application 10/780802 discloses the following limitations indicated in normal font, corresponding to the limitations in the US Patent indicated in italic:

1). A protective screen for screening off a suction space and a suction duct connected to it, in an emergency cooling system of a nuclear power plant, said protective screen including::

1'). Strainer wall for screening off a suction space and a suction duct connected to it in an emergency cooling system of a nuclear power plant, said strainer wall including;

2). at least one screen wall element having a suction side and an outflow side wherein the screen wall element is built up of one or more modular **rectangular** cassette units and wherein the cassette units each contain a plurality of screen pockets which are open towards the suction side spaced apart walls and one or more intermediate walls arranged between and apart from the spaced apart walls, which intermediate walls are formed as double walls allowing fluid flow inside the double walls;

*2'). at least one strainer wall element having an inlet side and an outflow side, wherein the inlet side is oriented inclined or perpendicular; the strainer wall element is built up of one or more modular cassette units (**not necessary claimed to be rectangular**); wherein the screen elements are made as suction pockets that are surrounded by outflow gaps which are connected to the outflow side or are open to the outflow side, and the cassette units each contain a plurality of screen elements which are open towards the inlet side and which are connected to the outflow side;*

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3). and bent perforated wall segments spanning the distance between two consecutive intermediate walls and between a spaced apart wall and an intermediate wall, in order to form the screen pockets, said screen pockets having lateral sides and being surrounded by outflow gaps, said outflow gaps being connected to the outflow side or open towards the outflow side;

3'). the cassette units contain bent wall segments between outer walls and/or one or more intermediate walls in order to form the suction pockets, wherein the bent wall segments comprise essentially U-shaped bent perforated wall segments;
and wherein the cassette units are configurable for placement in a row in order to assemble the screen wall element in the desired size.

Conversely, claim 1 of US Patent No. 7,211,190 B2 discloses limitations (printed in italic) with following limitations of Claim 1 of Application 10/780802:

1'). Strainer wall for screening off a suction space and a suction duct connected to it in an emergency cooling system of a nuclear power plant;

1). A protective screen for screening off a suction space and a suction duct connected to it, in an emergency cooling system of a nuclear power plant, said protective screen including:

2') said strainer wall including at least one strainer wall element having an inlet side and an outflow side, wherein the inlet side is oriented inclined or perpendicular; the strainer wall element is built up of one or more modular cassette units; and the cassette units each contain a plurality of screen elements which are open towards the inlet side and which are connected to the outflow side, wherein the screen elements are made as

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suction pockets that are surrounded by outflow gaps which are connected to the outflow side or are open to the outflow side;

2). at least one screen wall element having a suction side and an outflow side, wherein the screen wall element is built up of one or more modular rectangular cassette units and wherein the cassette units each contain a plurality of screen pockets which are open towards the suction side, spaced apart walls and one or more intermediate walls arranged between and apart from the spaced apart walls, which intermediate walls are formed as double walls allowing fluid flow inside the double walls,

2'). and the cassette units contain bent wall segments between outer walls and/or one or more intermediate walls in order to form the suction pockets, wherein the bent wall segments comprise essentially U-shaped bent perforated wall segments;

2). and bent perforated wall segments (**not necessary claimed to be** essentially U-shaped) spanning the distance between two consecutive intermediate walls and between a spaced apart wall and an intermediate wall, in order to form the screen pockets, said screen pockets having lateral sides and being surrounded by outflow gaps, said outflow gaps being connected to the outflow side or open towards the outflow side, and wherein the cassette units are configurable for placement in a row in order to assemble the screen wall element in the desired size.

It has been held that a shape capable of performing the claimed function constitutes a case of *prima facie* anticipation. In re Schreiber, 128 F.3d at 1478, 44 USPQ2d at 1432.

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Moreover, both the rectangularity of the cassette units and the U-shape of the bent perforated wall segment could well have been claimed in the US patent and in the application, respectively, having been disclosed in the respective Specifications (see “Summary of the Invention”, fourth paragraph, in the US Patent for disclosure of rectangular cassette units, and see page 3, central paragraph, of the instant application’s Specification, for disclosure of the U-shaped form of the bent wall sections).

Claim limitations of the Applicant’s claim 1 are obvious over said US Patent.

FIG. 2 of the Application is obvious over FIG. 3 of said Patent; FIG. 3 of the Application is obvious over FIG. 4 of said Patent; FIG. 4 of the Application is obvious over FIG. 5 of said Patent; FIG. 5a of the Application is obvious over FIG. 6a of said Patent; FIG. 5b of the Application is obvious over FIG. 6b of said Patent; FIG. 5c of the Application is obvious over FIG. 6c of said Patent.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention

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was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims **1 and 3-12** are rejected under 35 U.S.C. 103(a) as being obvious over Kielbowicz (US Patent No.5,759,398; '398 hereinafter; cited before) in view of Rivers (U.S. Patent # 4,049,406)).

Regarding claim **1**, '398 discloses: a protective screen for screening off a suction space and a suction duct connected to it, in an emergency cooling system of a nuclear power plant (title, abstract, column 1, lines 5+, column 2, lines 1+), said protective screen including: at least one screen wall element having a suction side and an outflow side (11, 12, 13 in FIG2, 3, 4, 5, column 2, lines 24+, column 3, lines 1+), wherein the screen wall element is built up of one or more modular cassette units (combination of pockets 14 shown in FIGs. 3, 4, 5, column 2, lines 24+; rectangular definition: crossing, lying, or meeting at a right angle; having edges, surfaces, or faces that meeting at right angles (Merriam-Webster collegiate dictionary. -10th edit., 1998; page 978)) and wherein the cassette units each contain a plurality of screen pockets which are open towards the suction side (14 in Figs. 3, 4, 5, column 2, lines 24+) spaced apart walls and one or more intermediate walls arranged between and apart from the spaced apart walls, which intermediate walls are formed as double walls allowing fluid flow inside the double walls (sequences of close locating wall 11, 12 are equal to said intermediate walls and a **sequence of flange 4 and a close locating wall 16 is service as spaced apart wall**, because some said wall can be made without perforation), and bent perforated wall

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segments spanning the distance between two consecutive intermediate walls and between spaced apart wall and an intermediate wall (13 in FIGs. 3, 4, 5, column 2, lines 24+, column 3, lines 1+), in order to form the screen pockets, said screen pockets having lateral sides and being are surrounded by outflow gaps, said outflow gaps being connected to the outflow side or open towards the outflow side (14 in FIGs. 3, 4, 5, column 3, lines 3+), and wherein the cassette units are configurable for placement in a row in order to assemble the screen wall element in the desired size (as shown in FIG. 2; the prior art meets the claim language).

'398 does not teach the new limitation: cassette units having rectangular sides.

However, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include said limitation in view of Rivers, drawn to apparatus for removing of an undesirable impurity i. e. solving the same problem who teach an rectangular cassette unit of filtration element as shown in FIG. 1, column 2, lines 20+. It is obvious for ordinary skill in the art at the time the invention was made to screen the suction space 6 (in FIG. 1, 2,3 of '398) from an inlet region by a plurality of cassette units having rectangular sides similar to a Rivers cassette with filter design similar to '398 because the recangular cassettes are better for shielding a larger area and '398 filtaar design is better for debris collection. It is obvious for ordinary skill in the art at the time the invention was made that a cylindrical filter as shown in FIG. 1, 2, 3 of '398 is transformable to a flat filter similar to the Rivers cassette with conservation of said filter function (i.e. with predictable result).

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It is obvious for ordinary skill in the art at the time the invention was made that a plurality of said rectangular cassette unit is capable to be connected side by side into the large protection system.

Motivation for said inclusion derives from Rivers: "this material must be capable of withstanding unusual operating characteristics such as high pressure, temperature, or an increased fluid flow rate", (column 1, lines 35+).

The claim would have been obvious because a person of ordinary skill has good reason to pursue the known options within his her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense (MPEP 2143).

According to MPEP 7.37.10 the recitation [for screening off a suction space and a suction duct connected to it, in an emergency cooling system of a nuclear power plant] has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

In reference to the claim language referring to claim 1, intended use and other types of functional language must result in a structural difference between the claimed

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invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In re Casey, 152 USPQ 235 (CCPA 1967); In re Otto, 136 USPQ 458, 459 (CCPA 1963).

In this particular case a screening elements (a protective wall) designed according to '398 with River's modification configurable for placement in a row in order to assemble the screen wall element in desired size.

On claim 3, '389 teaches: the screen pockets are each surrounded on their lateral sides by outflow gaps (13 in FIG. 2, 14 in FIGs. 3, 4, 5, column 2, lines 24+, column 3, lines 1+).

On claim 4, '389 teaches: the bent perforated wall segments are bent in a substantially U-shaped form (13 in FIGs. 3, 4, column 2, lines 24+, column 3, lines 1+).

On claim 5, '389 teaches: the screen pockets have a depth of greater than 0.1 m. The depth of the sieve pockets disclosed by '389 is not given a specific value, and thus there is no explicit teaching with regard to claim 5. However, '389 states that the favorable ratio between the volume of the sieve and its effective sieve surface is due to the fact that water can flow through outwardly opening sieve pockets, each of which forms a partial sieving volume. In other words, the more convoluted the sieve structure – i.e., the deeper the pockets – the more accessible area there is for water to escape, the lower

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the flow rate of the water through any given aperture and the more constant the pressure regardless of debris accumulation (col. 3, lines 29-43). The claimed pocket depths are therefore result-effective variables that may be optimized within prior art conditions or through routine experimentations. See MPEP § 2144.05(II)(A). It would have been obvious to one skilled in the art at the time of invention to develop pockets having depths greater than 0.1 m for the screen taught by '389 in order to prevent undesirable pressure changes, a motivation disclosed by '389 as stated above.

Applicant's argument that "the parameters are different" between aforementioned circuits does not convince because parameter adjustment per se is within the capabilities of ordinary skill in the art.

Counter to applicant insistence on TSM as the acceptable obviousness rejection:

The claim would have been obvious because a person of ordinary skill has good reason to pursue the known options within his her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense (MPEP 2143).

On claim **6**, '389 teaches: the spaced apart walls of the cassette units are formed as double walls having outflow gaps (sequences of walls 11, 12 as shown in FIG. 2; column 2, lines 24+)

On claim **7**, '389 teaches: the spaced apart walls and the intermediate walls of the cassette units are clamped against one another by means of connection elements (bolts

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10 in FIGs. 1, 2, 3, 4, column 2 lines 24+)

On claim **8**, '389 teaches: any of the spacings between the spaced apart walls and intermediate walls is determined in part by spacer elements disposed between the spaced apart walls and intermediate walls (spacers 21, 22 in FIGs. 2,, 5, column 3, lines 14+).

On claim **9**, '389 teaches: any of the walls or intermediate walls or the perforated and bent wall segments are manufactured from perforated sheet metal (11, 12, 13 in FIGs, 2, 3, 4, 5, column 3, lines 4+).

On claim **10**, '389 additionally teaches: the suction pockets have a depth of greater than 0.2 m.

The depth of the sieve pockets disclosed by '389 is not given a specific value, and thus there is no explicit teaching with regard to claim 10. However, '389 states that the favorable ratio between the volume of the sieve and its effective sieve surface is due to the fact that water can flow through outwardly opening sieve pockets, each of which forms a partial sieving volume. In other words, the more convoluted the sieve structure – i.e., the deeper the pockets – the more accessible area there is for water to escape, the lower the flow rate of the water through any given aperture and the more constant the pressure regardless of debris accumulation (col. 3, lines 29-43). The claimed pocket depths are therefore result-effective variables that may be optimized within prior art

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conditions or through routine experimentations. See MPEP § 2144.05(II)(A). It would have been obvious to one skilled in the art at the time of invention to develop pockets having depths greater than 0.2 m for the screen taught by '389 in order to prevent undesirable pressure changes, a motivation disclosed by '389 as stated above.

Applicant's argument that "the parameters are different" between aforementioned circuits does not convince because parameter adjustment per se is within the capabilities of ordinary skill in the art.

Counter to applicant insistence on TSM as the acceptable obviousness rejection:

The claim would have been obvious because a person of ordinary skill has good reason to pursue the known options within his her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense (MPEP 2143).

On claim **11**, '389 additionally teaches: any of the spacings between the two sides of a double wall is determined by Spacer elements disposed between the two sides of the double wall (bolts 10 can service as spaces between the two sides of a double as shown in FIGs. 3, 4).

On claim **12**, '389 additionally teaches: any of the spacings between the intermediate walls is determined by spacer elements disposed between the intermediate walls (spacers 21, 22 in FIGs. 2, 5, column 3, lines 17+).

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vadim Dudnikov whose telephone number is 571- 270-1325. The examiner can normally be reached on 8:00 - 17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack W. Keith can be reached, Mon-Fri 7:00am-4:00 pm, at telephone number 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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9. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

VD. 11/29/08.

/Jack W. Keith/

Supervisory Patent Examiner, Art Unit 3663